

REMARKS

This Amendment and Response is intended to fully respond to the Office Action mailed June 18, 2004. Claims 1-12 were examined in the Office Action and claims 1, and 5-12 stand rejected. Claims 2-4 were objected to. More specifically, claims 1, 5, 6, 8 and 9 stand rejected under 35 U.S.C. § 102(e) as being anticipated by United States Patent Number 6,529,732 issued to Vainiomaki et al. (hereinafter "Vainiomaki") and claims 7 and 10-12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Vainiomaki in view of United States Patent Number 5,335,355 issued to Tanaka et al. (hereinafter "Tanaka"). Claims 2-4 are objected to as being dependent upon a rejected base claim, claim 1.

In view of these remarks, reexamination and reconsideration are respectfully requested.

Claim Rejections - 35 U.S.C. § 102

Claims 1, 5, 6, 8 and 9 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Vainiomaki.

Applicants respectfully traverse the § 102(e) rejections. The Examiner has failed to substantiate a prima facie case of anticipation. Indeed, a prima facie case of anticipation can only be met when the reference teaches every aspect of the claimed invention. See MPEP §§ 706.02 and 2136. In this case, Vainiomaki does not teach all of the claim limitations, e.g., the comparing of cell receiver transfer data or the modifying of cell receiver transfer data.

As defined in the claims, the present invention relates to methods and systems for reconciling cell face or cell receiver transfer data in one form to match cell face or cell receiver transfer data in another form. Embodiments of the invention include automatic read and comparison modules for reading cell receiver transfer data from one form and automatically comparing the cell receiver transfer data to the data in another form. An automatic modification module automatically changes cell receiver transfer data entries in one form to match data in entries of another form. Cell receiver transfer data is involved in the process of selecting and switching cellular calls among cell faces. That is, a method according to one embodiment of the present invention involves comparing and modifying data regarding cell sites (cell antennas) and the cell faces (cell receivers) mounted to those cell sites. In particular, the cell receiver transfer

data includes a list, such as a directed retry list, of available cell sites and the corresponding cell faces that can receive a signal transferred from another cell site. This cell receiver transfer data is independent from the cell phones attached to the network or the subscriber data describing those cell phones.

Applicants agree that Vainiomaki compares and modifies subscriber service data, but Vainiomaki does not compare or modify any cell receiver transfer data. Vainiomaki describes a method and system for helping users of cell phone services maintain their normal package of services, call forwarding, call waiting, caller ID, email, etc., when the cell phone is roaming between two different or dissimilar cellular networks. See col. 1 lines 24 - col. 6, line 11; see also col. 7, line 60 – col. 9, line 50. To accomplish this objective, Vainiomaki modifies the subscriber data (data about the cell phone and services supplied to the cell phone) to use in different formatted networks. See col. 5, line 15 – col. 6, line 11. Vainiomaki, thus, determines if services provided to a subscriber are available in another network, converting subscriber data or service data for use in the other network if necessary, and transferring the converted subscriber data or service data to the other network. Col. 5, lines 40 – 59.

Subscriber/service data and cell receiver transfer data are two wholly different things. Vainiomaki defines subscriber data and/or service data as, “relating to features of the subscribed services which have been determined as being supported .” Col. 5, lines 50-52. Further, Vainiomaki describes features or services as services like call forwarding, CAMEL, or IN. See col. 3, lines 5-10; col. 4, lines 4-15; col. 5, lines 4-9. In contrast, embodiments of the present invention involve cell receiver transfer data. Modifying subscriber data is different than modifying cell transfer data because modifying subscriber data only allows the user to maintain their suite of services while roaming and the modifying of cell transfer data ensures that enough capacity exists on a cellular network to receive and maintain cellular calls, regardless of the services provided to the individual cells.

Thus, as a matter of law, Vainiomaki does not anticipate the present invention because it simply does not disclose, implicitly or explicitly, comparing or modifying cell receiver transfer data.

Given that Vainiomaki does not disclose, explicitly or implicitly, all the claim limitations of the present invention, claims 1, 5, 6, 8, and 9 are believed to be allowable over the prior art. That is, because Vainiomaki does not disclose the comparison or modification of cell receiver transfer data, Vainiomaki does not anticipate claims 1, 5, 6, 8, and 9. Similarly, all claims depending from those claims are also believed to be allowable and reconsideration of the outstanding rejections in light of these remarks is respectfully requested.

Claims Rejections - 35 U.S.C. § 103

Claims 7 and 10-12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent Number 6,529,732 issued to Vainiomaki et al. (hereinafter “Vainiomaki”) in view of United States Patent Number 5,335,355 issued to Tanaka et al. (hereinafter “Tanaka”).

Applicants respectfully traverse the section 103 rejections. The Examiner has failed to substantiate a prima facie case of obviousness because one or more of the requirements of a prima facie case is absent. Indeed, such a prima facie case can only be met when **all** of the following requirements are met: (1) there must be some suggestion or motivation in the references themselves (or in the knowledge available to those skilled in the art) to combine the references; (2) there must be a reasonable expectation of success; and (3) the combined references must teach or suggest all the claim limitations. See MPEP §§ 706.02(j) and 2143. In this case, the combination of Vainiomaki and Tanaka does not teach all of the claim limitations, e.g., the comparison or modification of cell receiver transfer data, in particular, the comparison and modification of data in a directed retry list of a Cell Equipage Face form or a Reselection List form, and there is no motivation to combine the references.

Tanaka describes a system to designate the communication mode of a cell phone, either digital or analog. As with the Vainiomaki, Tanaka does not disclose cell transfer data used in the process of selecting and switching cell faces for cellular calls. Designating the communication mode is different from modifying the cell transfer data because the communication mode is immaterial to which cell face can receive the call once the mode is designated.

Furthermore, there is no motivation to combine the references. Applicants would like to draw the Examiner’s attention to the case of In re Sang Su Lee, 277 F.3d 1338; 61 U.S.P.Q.2d

1430 (Fed. Cir. 2002). An examiner must demonstrate a motivation to combine shown in the objective teaching of the prior art or by the knowledge of one skilled in the art. Id at 1343. In addition, the motivation cannot be resolved on subjective belief and unknown authority. Id. The examiner, “must not only assure that the requisite findings [as to the motivation to combine] are made, based on evidence of the record, but must also explain the reasoning by which the finding are deemed to support the agency’s conclusion.” Id. Thus, Examiner has failed to provide the appropriate information to show a motivation to combine. Without the motivation to combine, Examiner has not set forth the prima facie case for obviousness.

Thus, as a matter of law, for the aforementioned reasons, Applicants assert that the combination of Vainiomaki and Tanaka does not disclose, implicitly or explicitly, all the claim limitations in the present invention.

Given that the combined references do not teach or suggest all the claim limitations of claims 7, 10-12, all claims are believed to be allowable over the prior art. That is, because Vainiomaki and Tanaka do not disclose the comparing and modifying of cell receiver transfer data, particularly directed entry lists in Cell Equipage Face forms or Reselection List forms, claims 7, 10-12 are not obvious in light of Vainiomaki and Tanaka. Furthermore, since there is no motivation to combine these references, it is further believed that claims 7, 10-12 are allowable over Vainiomaki and Tanaka for this additional reason. Similarly, all claims depending from those claims are also believed to be allowable and reconsideration of the outstanding rejections in light of these remarks is respectfully requested.

Allowable Subject Matter

Claims 2-4 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants believe these claims are now allowable after consideration of the remarks regarding the rejection of claim 1.

Conclusion

As originally filed, the present application included 12 claims, 3 of which were independent. As amended the present application includes 12 claims 3 of which are independent.

Application No. 09/918,754

It is believed that no further fees are due with this Response. However, the Commissioner is hereby authorized to charge any deficiencies or credit any overpayment with respect to this patent application to deposit account number 13-2725.

In view of the above amendments and remarks, Applicant respectfully requests a Notice of Allowance. If the Examiner believes a telephone conference would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the below-listed telephone number.

Respectfully submitted,

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